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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/768,975	01/30/2004	Shohei Chida	3335-00012	4526
26753	7590	10/23/2006		
ANDRUS, SCEALES, STARKE & SAWALL, LLP 100 EAST WISCONSIN AVENUE, SUITE 1100 MILWAUKEE, WI 53202				
			EXAMINER SORKIN, DAVID L	
			ART UNIT 1723	PAPER NUMBER

DATE MAILED: 10/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/768,975

Applicant(s)

CHIDA ET AL.

Examiner

David L. Sorkin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,4-7,9,11,12,14 and 21-24 is/are pending in the application.
- 4a) Of the above claim(s) 1 and 2 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4-7,9,11,12,14 and 21-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 4-7, 9, 1, 12, 14 and 21-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Manser et al. (US 5,415,884). Manser ('884) discloses a pipe-type mixer apparatus (1) comprising a mixing pipe passage having an upstream supply portion (2) and a downstream discharge portion (12); a shaft member (14) coaxially pivoted within the mixing pipe passage; a screw vane (5) and an agitating blade (16, 9 and/or 6) arranged in parallel in the order from an upstream side on the outer surface of the shaft member; a rotation driving means (see col. 5, lines 10-12; Fig. 9) of driving the shaft member; and a second fluid material supplying port (through 6) arranged in a corresponding position to the agitating blade in the shaft member, the second fluid material supplying port being arranged in the shaft member; wherein the pipe-type mixer is structure such as to rectify the first fluid material supplied into the mixing pipe passage by the rotating screw vane, thereafter supply a second fluid material to the first fluid material from the second fluid material supplying port in the shaft member, agitate and mix the first fluid material and the second fluid material by the rotated agitating blade, and discharge the agitated and mixed material via the discharge portion (see Fig. 1). The apparatus claims make reference to various intended acts, and material

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intended to be acted upon. Applicant is reminded that "apparatus claims cover what a device *is*, not what a device *does*" (emphasis in original) *Hewlett-Packard v. Bausch & Lomb Inc.* 15 USPQ2d 1525, 1528 (Fed. Cir. 1990); "the manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself" *In re Casey*, 152 USPQ 235 (CCPA 1967); "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). "Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim." *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969) and "inclusion of material or article worked upon by a structure being claimed, does not impart patentability to the claims" *In re Otto* 136 USPQ 458, 459 (CCPA 1963). The shaft is hollow and the second fluid supplying port communicates with the hollow interior of the shaft member (see Fig. 1). The second fluid supplying port is located in a position corresponding to the middle of agitating blade 6. The apparatus comprises a base end opening the communicated with a supply pipe passage via a swivel (see Fig. 1, left end). The second fluid material is supplied to a forming portion (6) of the agitating blade from the supply pipe passage in order via the interior of the shaft member and the second material fluid supplying port (see Fig. 1).

3. Claims 4-7, 9, 1, 12, 14 and 21-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Dollinger (US 4,101,001). Dollinger ('001) discloses a pipe-type mixer apparatus comprising a mixing pipe passage (2) having an upstream supply portion (6)

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and a downstream discharge portion (8); a shaft member (16) coaxially pivoted within the mixing pipe passage; a screw vane (70) and an agitating blade (22) arranged in parallel in the order from an upstream side on the outer surface of the shaft member; a rotation driving means (28) of driving the shaft member; and a second fluid material supplying port (through 22) arranged in a corresponding position to the agitating blade in the shaft member, the second fluid material supplying port being arranged in the shaft member; wherein the pipe-type mixer is structure such as to rectify the first fluid material supplied into the mixing pipe passage by the rotating screw vane, thereafter supply a second fluid material to the first fluid material from the second fluid material supplying port in the shaft member, agitate and mix the first fluid material and the second fluid material by the rotated agitating blade, and discharge the agitated and mixed material via the discharge portion (see Fig. 1). The apparatus claims make reference to various intended acts, and material intended to be acted upon. Applicant is reminded that "apparatus claims cover what a device *is*, not what a device *does*" (emphasis in original) *Hewlett-Packard v. Bausch & Lomb Inc.* 15 USPQ2d 1525, 1528 (Fed. Cir. 1990); "the manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself" *In re Casey*, 152 USPQ 235 (CCPA 1967); "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). "Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim." *Ex parte Thibault*, 164 USPQ 666, 667

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(Bd. App. 1969) and "inclusion of material or article worked upon by a structure being claimed, does not impart patentability to the claims" *In re Otto* 136 USPQ 458, 459 (CCPA 1963). The shaft is hollow and the second fluid supplying port communicates with the hollow interior of the shaft member (see Figs. 1 and 2). The second fluid supplying port is located in a position corresponding to the middle of agitating blade (see Figs. 1 and 2). The apparatus comprises a base end opening the communicated with a supply pipe passage via a swivel (see Fig. 1). The second fluid material is supplied to a forming portion (22) of the agitating blade from the supply pipe passage in order via the interior of the shaft member and the second material fluid supplying port (see Figs. 1 and 2).

### ***Response to Arguments***

4. The currently amended claims are not rejected under section 112.
5. Applicant's arguments with respect to the prior art have been considered but are moot in view of the new grounds of rejection.

### ***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David L. Sorkin whose telephone number is 571-272-1148. The examiner can normally be reached on 9:00 -5:30 Mon.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L. Walker can be reached on 571-272-1151. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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A handwritten signature in black ink, appearing to read "David L. Sorkin". The signature is fluid and cursive, with the first name "David" and last name "Sorkin" clearly distinguishable.

David L. Sorkin  
Primary Examiner  
Art Unit 1723

DLS